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In the

Supreme Court of the United States

OCTOBER TERM, 1967.

PHILLIPS PETROLEUM COMPANY,
Petitioner,

vs.

EDWARD J. BRENNER,
United States Commissioner of Patents,
Respondent,

and

PHILLIPS PETROLEUM COMPANY,
Petitioner,

vs.

GOODRICH-GULF CHEMICALS, INC.,
and MONSANTO COMPANY,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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and MONSANTO COMPANY,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

Petitioner, Phillips Petroleum Company, respectfully petitions for a writ of certiorari to the United States Court of Appeals for the District of Columbia Circuit.

OPINIONS BELOW

The opinion of the Court of Appeals is reported at .... F.2d ...., and is printed in the Appendix hereto, *infra*, p. 1a.

The opinion of the District Court for the District of Columbia is reported at 260 F.Supp. 45, and is printed in the Appendix hereto, *infra,* p. 8a.

The decision of the Board of Patent Interferences in the Patent Office is printed in the Appendix hereto, *infra,* p. 12a. The decisions of the First Assistant Commissioner in the Patent Office are printed in the Appendix hereto, *infra,* p. 17a and p. 19a.

JURISDICTION

The judgment of the Court of Appeals was entered on June 29, 1967, and became final on August 16, 1967, upon denial of a timely petition for rehearing. On August 31, 1967, the transmission of the opinion and judgment of the Court of Appeals to the District Court was ordered stayed for the period permitted for the filing of this petition.

The jurisdiction of this Court is invoked under 28 U.S.C. Sec. 1254(1).

QUESTIONS PRESENTED

1. Do the "idiosyncrasies of Patent Office practice" immunize that agency from judicial review of its denial of procedural due process in an interference, prior to its determination of priority of invention?

2. Do the statutory special review procedures for technical factual determinations by the Patent Office preclude the equity jurisdiction of an United States District Court over issues of procedural due process, including petitioner's right of cross-examination and right to see the evidence of record of opposing parties?

3. Should the courts refrain from granting relief to a petitioner aggrieved by agency action, where

a. the issues tendered are purely legal and peculiarly appropriate for judicial resolution,

b. concededly, hardship to the petitioner is inevitable if judicial relief is denied,

c. no factual issue needs to be resolved by the agency before the courts can act, and

d. no public interest or urgency requires that the courts delay their review until after the formal termination of the agency proceedings.

STATUTES INVOLVED

35 United States Code, Sec. 135, "Interferences"

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. . . ."

35 United States Code, Sec. 141, "Appeal to Court of Customs and Patent Appeals"

". . . A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to

section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case."

35 United States Code, Sec. 146, "Civil action in case of interference"

"Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

"Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the

marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law."

Pertinent portions of Title 5, United States Code, Sections 1002 and 1009, are set forth in the Appendix hereto, *infra,* pp. 20a-22a. (Since these cases were begun on June 2, 1966, these sections have been superseded respectively by Sections 552 and 701-706, of Title 5, U.S.C., approved September 6, 1966, in Public Law 89-554, 80 Stat. 378.)

Pertinent portions of the Rules of Practice of the United States Patent Office in patent cases, Rules 225, 226, 227, 247, 248, 251, 253, 256, 271, 273, 279 and 285, are also set forth in the Appendix hereto, *infra,* pp. 22a-27a.

STATEMENT OF THE CASE

These actions were brought for declaratory and injunctive relief, asking the District Court for the District of Columbia to compel the respondents to recognize the rights of petitioner's inventors to a fair *inter partes* hearing in a pending Patent Office interference.

Petitioner's inventors have filed one of three patent applications now involved in the interference. The sole purpose of that proceeding is to determine who was the first inventor and who is entitled to receive the patent. At the instance of the other competing applicants, the

Patent Office has ordered that petitioner's inventors shall be prohibited from attending during the testimony of the other two parties, and shall not be permitted even to inspect the record of testimonial and documentary evidence made by the rival inventors (App. 2a). The Patent Office has also ordered that when the final oral hearing is held, from which the award of the patent is to come, petitioner's inventors may present their case but they shall not be present to hear or answer all the arguments of the other two parties (App. 3a).

The bases for federal jurisdiction of these cases in the court of first instance were 28 U.S.C., §§ 1338(a) and 2201; 5 U.S.C., § 1009; Rule 81(b), F.R.C.P.; and the inherent power of equity jurisdiction. Petitioner asked the court for relief against denial of procedural due process by a federal agency.

The District Court said that it was "impressed with the force of the argument of plaintiff's counsel that the plaintiff is placed at a disadvantage in not being permitted to participate in the taking of testimony in behalf of his two opponents" (App. 11a). However, the court granted motions to dismiss because it felt that there were "binding precedents" prohibiting its review of what it considered were "interlocutory orders" (App. 9a-10a). The Court of Appeals affirmed but on opposite grounds. Whereas the District Court held that the precedents precluded its intervention, the Court of Appeals held that courts of equity have all the power necessary to correct whatever injustice is done in the agency proceeding but that the peculiarities of Patent Office procedures inhibit the courts from exercising that power (App. 4a):

> "The idiosyncrasies of Patent Office practice, and the unusual terminology of the practitioners, reinforce customary doctrines of judicial restraint."

The Patent Office had justified its extraordinary rulings (no precedents have been found by the parties or the agency) by citing "logic and the equities" (App. 15a). In detail, the material history of the Patent Office proceedings is as follows:

On July 16, 1964, the Patent Office declared an interference between an application owned by petitioner and two applications owned by Goodrich-Gulf and Monsanto, the respondents in appeal No. 20,677. (The case against the other parties and the case against the Commissioner of Patents were consolidated for all purposes by order of Chief Judge Bazelon entered December 30, 1966.) Preliminary statements of the applicants revealed that the earliest date of invention alleged by petitioner's inventors was subsequent to the filing dates of the rival applications (App. 2a). The Patent Interference Examiner thereupon gave notice that judgment on the record would be entered against petitioner's inventors unless they could show cause why it should not be (*Ibid*).

Petitioner's inventors met the requirements of the show cause order by moving, in accordance with settled practice, to dissolve the interference on the ground, *inter alia*, that the other inventors had no right to the contested claim since it was not disclosed in their applications (App. 2a, Ct's op.). This claim is to a process of making synthetic rubber using a specific catalyst. Petitioner's motion to dissolve pointed out that the other inventors laid no claim to this process until after 1963, when they learned that petitioner was claiming it. Petitioner's process became public in the course of its successful suit against the Commissioner of Patents (219 F.Supp. 366, D.D.C. 1963) to compel the issuance of a patent on a synthetic rubber product which can be made by the process (*Ibid*).

Petitioner's motion to dissolve was denied by the primary examiner but no judgment was entered against petitioner. It is still a party to the interference and is eligible to receive the process patent because its motion will be considered at final hearing in the interference.

The rules of procedure for interferences in the Patent Office (App. 22a-27a) include appropriate requirements of notice, service of papers and attendance of parties during hearings and the taking of testimony, including specifically a party's right of cross-examination. However, after petitioner's motion was set down for consideration at final hearing, the opponents proceeded to take testimony of their witnesses without giving notice to petitioner as required by Patent Office Rule 273 (App. 25a). The Patent Office then permitted the two opposing parties to put in this evidence which had been developed without cross-examination by petitioner. Petitioner has also been shut off from its opponents' records and briefs and will not be permitted to participate in that part of the final hearing at which their evidence and arguments will be considered.

Petitioner's attempts to obtain equal treatment in the Patent Office, including appropriate motions and petitions to the Commissioner of Patents, have all failed (App. 17a-19a). There was no remaining administrative avenue for relief or review open to petitioner when it brought the present actions.

REASONS FOR GRANTING THE WRIT

A. The Court of Appeals has decided an important question of federal law which has not been, but should be, settled by this Court. This question is whether the peculiarities of the practice before the Patent Office should make that agency uniquely free of judicial review. The Court of Appeals decided the question wrongly and this Court has never considered it.

B. The Court of Appeals decision granting special status to the Patent Office cannot be reconciled with this Court's decisions holding that the courts have the inherent power, as to the other agencies of government, to grant relief against arbitrary and unreasonable procedures and denial of procedural due process.

C. The Court of Appeals decision herein is apparently the first of a line of decisions in that court abdicating its power to review Patent Office action. See, for example, *Doyle* v. *Brenner,* ..... F.2d ....., 154 USPQ 464, 465 (decided July 21, 1967); and *Texas Instruments Inc.* v. *Brenner,* ..... F.2d ..... (decided October 27, 1967). The latter decision was a bare *per curiam* affirmance.

ARGUMENT

The Agency Action Against the Petitioner Is Beyond the Scope of the Agency's Authority and Constitutes a Clear-cut Injury to Petitioner.

The right of an inventor to a patent is a valuable property right derived from Article 1, Section 8, of the Constitution of the United States. The respondent Commissioner of Patents has the statutory duty to administer the law as to the granting of patents, and he has the authority to "establish regulations, *not inconsistent with law,** for the conduct of proceedings in the Patent Office" (35 U.S.C., § 6). The Commissioner has, accordingly, promulgated many Rules of Practice, including the following Rules relating to the conduct of *inter partes* interferences between opponents claiming the same invention.

Rule 226 gives each party access to his opponent's application. Rule 247 requires that every paper filed (with certain exceptions not relevant here) must be served upon other parties. Rule 251 assigns times for the parties to take their testimony-in-chief and rebuttal testimony. Rule 253 requires that a true copy of a party's testimony must be served upon each of his opponents. Rule 256 provides for a final hearing at which any party who appears will be heard. Rule 271 provides that evidence which has "not been taken and filed in compliance with" the rules will not be considered. Rule 273 requires that a party must give written notice to his opponents of the taking of a deposition, with "full opportunity" of cross-examination of witnesses. Rule 279 provides that after

* Emphasis added.

testimony has been filed, it may be inspected by any party. And Rule 285 recognizes the rights of parties to raise formal, procedural, and substantive objections to an opponent's evidence. (App. 22a-27a).

In this case, all of the foregoing Rules were ignored. The opposing parties were permitted to take testimony without notice to petitioner, without opportunity for cross-examination or objection by petitioner, and petitioner has been denied access to the record of that testimony and the documentary evidence.

This extraordinary treatment of petitioner is above and beyond any rules which the Patent Office has made or lawfully could have made. The Patent Office tried to justify its procedure by saying that the priority testimony of petitioner's opponents could have no bearing on petitioner's case against them (App. 15a). This cannot be true! The entire testimony and other evidence of petitioner's opponents must be directed to their attempts to prove that they made the invention on the earliest possible date. In order to make such proof, they must obviously prove what it was that they "invented." But petitioner's whole case depends upon proving that its opponents never did make the invention. The strength or weakness of the opponents' evidence must, therefore, be crucial to petitioner's case. Keeping that evidence in secret from petitioner is the clearest sort of denial of procedural due process.

The direct prejudice to petitioner from these procedures is inevitable. This interference will be decided on a defective record, and the decision will be presumptively correct under this Court's rule established in *Morgan* v. *Daniels*, 153 U.S. 120, 125 (1894). The defective record will also handicap petitioner under either of the two specific statutory channels for judicial review:

(1) In a suit brought under 35 U.S.C., § 146, the courts could not remand the matter to the Patent Office for reconsideration.* (2) In an appeal under 35 U.S.C., § 141, the appeal must be decided on the record made in the Patent Office.

A recent decision noting that either type of judicial review of an interference determination must be ineffectual to correct a defective record is *Ochsner* v. *Millis*, ... F.2d ...., 155 USPQ 195, 198 (6 Cir. 1967). As the Sixth Circuit recognized in that case, the only time the courts can act effectively in such a situation is before the Patent Office proceeding is terminated.

The "Idiosyncrasies of Patent Office Practice" Should Not Immunize that Agency from Judicial Review.

The quotation is, of course, from the opinion of the Court of Appeals in these cases. The point of this petition is that those eccentricities, whatever they are, should not place that agency above judicial review of a denial of procedural due process.

There is more than "idiosyncrasy" in being deprived of the rights of cross-examination of opposing witnesses and access to the record.

There is no question here but that the Patent Office personnel are peculiarly well qualified to decide the technical factual issues presented to them. Neither should there be any question but that the courts are historically

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* The Court of Appeals in this case was entirely wrong in saying that the District Court could provide relief equivalent to a remand by staying court proceedings pending further proceedings in the Patent Office (App. 6a). Once the court proceeding is begun under 35 U.S.C., § 146, the Patent Office has no jurisdiction to take any action at all affecting the subject matter.

and actually best qualified to judge purely legal issues such as those presented in these cases, or that the courts' exercise of that jurisdiction strengthens the administrative process (Davis, Unreviewable Administrative Action, 15 F.R.D. 411, 451).

The effect of the Court of Appeals' decision in this case, however, is that there can be no court review of any Patent Office orders in *inter partes* interferences except the terminal order, either under the two statutory procedures for review (35 U.S.C. §§ 141 and 146) or under the Administrative Procedure Act. The decision is inconsistent with the same court's holding, earlier in the same month, that an *ex parte* order of the Patent Office can be reviewed under the Administrative Procedure Act prior to final agency action, *Sikora* v. *Brenner*, 379 F.2d 134 (D.C. Cir. 1967). There can be no excuse, and the court offered none, for discriminating between orders entered in *ex parte* and *inter partes* proceedings.

More importantly, there can be no reason in law or in logic why a Patent Office interference should be a unique proceeding among the agencies of government. In *Shields* v. *Utah Idaho Cent. R.R. Co.*, 305 U.S. 177, 183-4 (1938), this Court said that the equity jurisdiction of the federal courts could be invoked to review an order of the ICC which merely fixed the status of the plaintiff. (The orders in the present case are comparable—since the Patent Office has fixed petitioner's status as that of a party to the interference, but without the rights of a party.)

In *Stark* v. *Wickard*, 321 U.S. 288, 308-10 (1944), this Court ordered the lower court to accept jurisdiction to review an order of the Secretary of Agriculture where there was no statutory provision for review. This Court said that judicial responsibility to determine the limits

of agency authority is implicit in the statutes establishing the courts.

In *Harmon* v. *Brucker,* 355 U.S. 579, 581-2 (1958), this Court held that judicial relief is available to one injured by an administrative decision in excess of administrative authority, even where the statutes said the decision was "final" and subject only to review within the agency.

In *Leedom* v. *Kyne,* 358 U.S. 184, 187-9 (1958), this Court held that the federal courts should take jurisdiction to review an unlawful certification order (which was not a "final" order) outside the channels of statutory review.

In *Rusk* v. *Cort,* 369 U.S. 367, 375, 379 (1962), this Court approved of a suit for declaratory and injunctive relief under the Administrative Procedure Act to review an order of the Department of State, again outside the statutory review procedures.

The Issues in These Cases Are Ripe for Judicial Determination.

This Court's most thorough recent discussion of the criteria for deciding when the courts should review administrative orders occurred in three companion cases earlier this year: *Abbott Laboratories* v. *Gardner,* 387 U.S. 136; *Toilet Goods Assn.* v. *Gardner,* 387 U.S. 158; and *Gardner* v. *Toilet Goods Assn.,* 387 U.S. 167. The criteria found most useful by this Court (both majority and dissenting opinions) can be distilled as follows:

Judicial review of final agency action will not be cut off unless there is persuasive evidence of Congressional intent to do so, and the Administrative Procedure Act embodies a basic presumption of judicial review, 387

U.S. 140. The enactment of statutory special-review procedures for an agency's technical factual determinations does not show a Congressional intent to eliminate the normal equity power of the courts to review other kinds of agency action, *id.* 144-5. The problem of ripeness is best considered according to whether the issues are purely legal and whether the agency action is "final," *id.* 148-9, and the hardship to the parties if judicial relief is denied, *id.* 162. "Finality," in turn, is a pragmatic term to be applied to formal, definitive and effective orders of the agency, which have an immediate impact upon those before it, *id.* 150-2, 162. In deciding whether to review an agency order, the courts should also consider whether judicial review would delay the administrative process, whether there is an important public interest of health or safety weighing against delay, *id.* 154-6, 178, 198; and whether any factual issues need to be resolved by the agency before the legal issues are reached by the courts, *id.* 171.

All of those criteria fit the present cases. The issues tendered are purely legal, relating only to procedural due process of law. The hardship to petitioner is undeniable if the agency hearing continues with petitioner unable to participate as a party but bound by the result. Furthermore, there are no factual issues which need resolution by the agency before the courts can act, and no public interest justifies a delay of judicial review until the agency's terminal order. Finally, nothing in the patent statutes prohibits present judicial review and no law or decision ever written justifies the Court of Appeals' special treatment of patent interferences. Simple

justice requires that the courts exercise their historic power to compel a fair hearing for this petitioner.

Respectfully submitted,

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November 13, 1967

APPENDIX

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 20,626

PHILLIPS PETROLEUM COMPANY
APPELLANT

v.

EDWARD J. BRENNER,
United States Commisssioner of Patents
APPELLEE

No. 20,677

PHILLIPS PETROLEUM COMPANY
APPELLANT

v.

GOODRICH-GULF CHEMICALS, INC.,

and

MONSANTO COMPANY
APPELLEES

Appeals from the United States District Court
for the District of Columbia

Before EDGERTON, *Senior Circuit Judge*, LEVENTHAL and ROBINSON, *Circuit Judges*.

LEVENTHAL, *Circuit Judge:* Appellant Phillips Petroleum Corporation (Phillips) brought an action against the Commissioner of Patents, and an accompanying action against two corporations, Goodrich-Gulf Chemicals, Inc., and Monsanto Company. The three companies are assignees of patent applications which were placed in interference by the Patent Office in July 1964. The alleged invention involves a process for producing polybutadiene polymers, used as a synthetic rubber. When the preliminary statements were opened the Patent Office noted that the Phillips inventors had sworn to conception date subsequent to the April 1955 filing dates of the other inventors. In October 1964 the patent interference examiner issued an order to show cause why judgment should not be entered against the Phillips inventors. Phillips countered by filing motions to dissolve the interference on the ground that the apparently senior applicants had no right to make their claim because of lack of adequate disclosure in the applications.[1]

The Phillips motion was denied by the primary examiner to whom it had been referred, but the patent interference examiner granted Phillips' request to consider this motion at the final hearing on the interference. If its motion is granted Phillips will of course have a victory over the other companies.

Meanwhile, however, the Monsanto and Goodrich-Gulf priority dispute has proceeded on its course without Phillips. Phillips has been excluded from the sessions where evidence was taken, has been denied access to the records and briefs of the other companies, and will not

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[1] They did not lay claim to a process involving the specific catalyst involved in the interference, says Phillips, until after the Phillips invention became public in 1963, when it successfully brought action to compel issuance of a product patent (not directly involved in this appeal). Phillips Petroleum Co. v. Ladd, 219 F.Supp. 366 (D.D.C. 1963).

be permitted to attend the final hearing. Its motion to dissolve will in effect be the subject of a separate presentation.

Phillips complains that it will be foreclosed from ascertaining and using admissions by the Monsanto and Goodrich-Gulf employees that support Phillips' position on the motion to dissolve. It says the Patent Office has arbitrarily changed in the middle of the game the rules of the Patent Office which provide, *e.g.*, that testimony in interference proceedings shall be taken on notice to opposing parties (Rule 273). The board of patent interferences held that the order restricting Phillips, while not specifically provided for in the rules of practice, is in accordance with logic and the equities.[2] The Commissioner denied reconsideration.

Phillips' complaint in the District Court against appellee Commissioner sought a decree declaring its right to participate fully in the interference proceeding, including the portion restricted by the Patent Office to the other two parties.[3]

The District Court dismissed appellant's complaint, ruling that it should not interfere with a pending proceeding in the Patent Office until it is brought to a conclusion, at which time it may review interlocutory rulings in an action to review the final order. *Anderson* v. *Watson*, 103 U.S.App.D.C. 99, 254 F.2d 956 (1958).

Appellant urges upon us that its case lies within an exception to the general rule invoked by the District Judge because substantial rights will be lost inevitably if

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[2] The board decided from analogy to other rules preserving secrecy of Patent Office files unless disclosure is required, and specifically to Rule 227(b), providing that junior party is not even entitled to the preliminary statements of others. Phillips was considered a stranger to the controversy of the others, without any necessity for being present at the hearing thereon.

[3] A companion action was also brought against the other companies seeking declaratory and injunctive relief.

the Patent Office proceeds on its present course. Appellant suggests it would have an adequate remedy if court proceedings after the final order were conducted in the Court of Customs and Patent Appeals under 35 U.S.C. § 141 (1964), because that court has authority to remand the case to the Patent Office. What appellant fears is that the other companies may elect under 35 U.S.C. § 141 "to have all further proceedings conducted as provided in Section 146." Appellant says that 35 U.S.C. § 146 (1964) contains no authority for the District Court to remand to the Patent Office.

We begin our discussion by disclaiming any intention of boring the non-patent bar, and amusing or mystifying the patent bar, by discussing at this juncture the Patent Office rules. The idiosyncrasies of Patent Office practice, and the unusual terminology of the practitioners, reinforce customary doctrines of judicial restraint.

While the Patent Office is unique in many ways, certain fundamental characteristics it shares with the other agencies of Government. First, it has the authority to act in accordance with fundamental principles of justice, by appropriate issuance and application of rules and use of good judgment on matters not covered by rules. Second, it is subject to judicial review and restraint in case of arbitrary rules or rulings that infringe on private rights.

Congress has not only provided for judicial review of Patent Office action in interference proceedings, it has provided two possible avenues: by appeal to the Court of Customs and Patent Appeals (35 U.S.C. § 141), or by "civil action" (35 U.S.C. § 146). However, the civil action remedy is available only to an applicant "who has been *finally* denied a patent because of a Patent Office decision against him and in favor of his adversary on the question of priority." *Sanford* v. *Kepner*, 344 U.S. 13, 15 (1952)[4] (Emphasis added).

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[4] The court was construing the former Section 63, predecessor of Section 146.

Appellant has not even had a determination of its motion to dissolve the interference proceeding. The mere disposition of that motion, one way or the other, is interlocutory, and the applicant cannot protest this action directly either by appeal to the Court of Customs and Patent Appeals[5] or by a civil action under Section 146.[6] The only final order in an interference proceeding is a determination of priority.

Appellant says its action is brought under the Administrative Procedure Act. To the extent that other statutory review provisions are inadequate there may be leeway to proceed under the Administrative Procedure Act for review of final Patent Office actions. We so held in *Sikora* v. *Brenner*,[7] and the propriety of that ruling has been fortified by the Supreme Court's recent exposition in *Abbott Laboratories* v. *Gardner*.[8] But even if review

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[5] Tenney v. Nordmeyer, 94 F.2d 396 (C.C.P.A. 1938).

[6] Ellis-Foster Co. v. Union Carbide & Carbon Corp., 284 F.2d 917, 926-27 (3rd Cir. 1960), *cert. denied*, 365 U.S. 813 (1961); American Cable Co. v. John A. Roebling's Sons, Co., 62 App.D.C. 168, 169, 65 F.2d 801, 802 (1933); Carlin v. Goldberg, 45 App.D.C. 540 (1917).

[7] —— U.S.App.D.C. ——, ——, —— F.2d ——, —— (No. 20634, May 8, 1967, slip op. 3-4).

[8] —— U.S. ——, 35 U.S.L.W. 4433 (U.S. May 22, 1967). The Supreme Court has reiterated that the generous review provisions of that act must be given a hospitable interpretation and has approved the view that only on a showing of clear and convincing evidence of a contrary legislative intention should the courts restrict access to judicial review. We think this principle applies not only where a specific statute is claimed to preclude judicial review, but also where it is invoked as delimiting the scope of judicial review. Meaningful judicial review embraces authority adequate to cope with and excise the aftermath of arbitrary rulings of the Patent Office, if any, that taint its final action and affect individual rights. In general, judicial review provisions of Title 3 marked an effort by Congress to assure, not to restrict, adequacy of judicial review of the Patent Office.

under 35 U.S.C. §146 proves inadequate, the only action provided under the Administrative Procedure Act is by review of final action, not by review of a procedural order.[9]

However, the scope of remedy available in an action under 35 U.S.C. § 146 is not as limited as appellant says. Actions under Title 35 may be decided so as to result in further proceedings in the Patent Office.[10] Without deciding whether the District Court may order a remand as such, it can provide equivalent relief by staying its proceeding pending further proceedings in the Patent Office.[11]

The prematurity of the present action plainly appears from consideration of the successive possibilities that may lie ahead: Appellant may prevail in the Patent Office on the motion to dissolve. The corporate appellees may acquiesce in review by the Court of Customs and Patent Appeals. Appellant may persuade the Patent Office that its practice of withholding issuance of patent when appeal has been taken to the Court of Customs and Patent Appeals should be extended so as to avoid giving an extra benefit to the patentee who elects to require that such appeal be displaced by a new court action.[12]

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[9] *See* 5 U.S.C. § 704 (Supp. II 1965-66):

> Agency actions made reviewable by statute and final agency action for which there is no other adequate remedy in a court are subject to judicial review. A preliminary, procedural, or intermediate agency action or ruling not directly reviewable is subject to review on the review of the final agency action.

[10] Hoover Co. v. Coe, 325 U.S. 79, 89 (1945)

[11] California Research Corp. v. Ladd, 123 U.S.App.D.C. 60, 65, 356 F2d 813, 818 (1966); Int'l Standard Elec. Corp v. Ooms, 81 U.S.App.D.C. 215, 157 F.2d 73 (1946).

[12] *See* the reference in Hoover Co. v. Coe *supra* note 10, 325 U.S. at 84, to the two statutory review provisions as "alternative remedies resulting in the same sort of relief." *See also* note 11 above. The customary Patent

Appellant's case is a far cry from those exceptional cases where a court may consider the validity of what is in form an interlocutory administrative order but is in substance a final determination of individual rights or a deprivation of a substantive statutory right.[13] Such exceptional authority is available only if the court is clearly convinced that review of final action would be completely unable to vindicate the statutory or substantive right. Courts have generally not found themselves powerless to fashion remedies needed to correct injustice. Just as equity developed the mandatory injunction, as courts unable to revise a jury verdict developed the remittur, as courts confronted with invalid administrative action fashioned the conditional injunctive decree, so courts reviewing arbitrary Patent Office final action will generally be able to fashion remedies they deem needful to correct injustices.[14]

To obviate any possible misunderstanding we add that our comments on the availability of remedies in a court review of a final Patent Office order in no way imply that we have concluded the Patent Office has acted improperly vis a vis appellant.

Affirmed.

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[13] (Continued)
Office practice as related on argument in the District Court, is to issue the patent in due course, within a few months, if recourse is had to a District Court under 35 U.S.C. § 146.

[13] *Cf.*, Leedom v. Kyne, 358 U.S. 184 (1958); Skinner & Eddy Corp. v. United States, 249 U.S. 557 (1919); Delta Air Lines v. CAB, 97 U.S.App.D.C. 46, 49, 228 F.2d 17, 20 (1955); Deering Milliken, Inc. v. Johnston, 295 F.2d 856 (4th Cir. 1961).

[14] There is a complication of sorts, since the Commissioner has general discretion to decline to intervene in an action under 35 U.S.C. § 146. Ellis-Foster Co. v. Union Carbide & Carbon Corp., *supra* note 6, 284 F.2d at 925. We need not consider to what extent there may be limitations on that discretion. The courts may issue appropriate orders to the private defendants.

UNITED STATES DISTRICT COURT
For The District Of Columbia

PHILLIPS PETROLEUM COMPANY,
Plaintiff,
v.
EDWARD J. BRENNER,
United States Commissioner of Patents,
Defendant.

Civil Action
No. 1436-66

OPINION

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This is an action against the Commissioner of Patents for a declaratory judgment and an injunction. The plaintiff is a party to an interference proceeding pending in the Patent Office. The declaratory judgment sought is an adjudication that certain interlocutory rulings, which will be hereafter mentioned, made by the Patent Office tribunals during the pendency of the proceeding, are erroneous and an injunction is prayed for against their enforcement. The defendant moves to dismiss the action on the ground that it does not lie and may not be maintained.

Briefly, the plaintiff and two other concerns are parties to an interference proceeding now pending in the Patent Office. The Patent Office Examiner issued a rule to show cause against the inventors, who are the applicants for the patent, which application is owned by the plaintiff, why judgment would be entered against them in view of the fact that they could not carry their date of invention back of the date of their application, whereas the other two applicants claimed earlier dates. The plaintiff responded that the other applicants should not be permitted to make the claim in interference on the ground that their disclosures were insufficient. The Examiner ruled against the plaintiff and the interference proceeded as between the other two applicants, each of whom was then in a position to take testimony.

The plaintiff requested permission to participate in the taking of the testimony and to cross-examine the witnesses,

as well as seeing a transcript of the testimony after it was taken. This application was denied and the denial was affirmed by the Board of Interference Examiners in the Patent Office. This conclusion was reached presumably on the ground that the testimony was being taken to determine which of the other two applicants had priority over the other, it having been decided that each of them could make the claim in interference and that the plaintiff was junior to each of the other two. Under Patent Office procedure the plaintiff could obtain, in effect, a reconsideration of his position on final hearing.

This action was then brought in order to secure an adjudication that the plaintiff has the right to participate in the interference proceeding without limitation, including the right to attend and cross-examine witnesses at the taking of any testimony of the other two parties and to take appropriate rebuttal testimony. An injunction is prayed for to set aside the contrary decisions of the Patent Office tribunals.

It has been noted, as has already been stated, that the Patent Office interference proceeding is still pending. It has not been brought to a conclusion. Testimony is still being taken and then a final hearing will take place before a final decision is made by the Patent Office. The basis of the motion made in behalf of the Commissioner of Patents to dismiss the complaint is that the Court should not interfere or interject itself during the pendency of the administrative proceeding and review interlocutory orders and that the sole remedy of the plaintiff, if the final decision of the interference proceeding goes against it, is to secure a review of the final decision of the Patent Office either by an appeal to the Court of Customs and Patent Appeals or by an action *de novo* in this Court, and that on either such an appeal or such an action the interlocutory orders of which the plaintiff complains may be reviewed.

This point was very ably and thoroughly argued on both sides. The Court is of the opinion that in accordance with the binding precedents and the general rule govern-

ing such matters, this Court should not interfere with the pending proceeding in the Patent Office until it is brought to a conclusion and then only it may review the interlocutory orders in an action sought to review the final order. This has been established in a number of cases in connection with Patent Office proceedings. *Anderson* v. *Watson*, 103 U.S.App. D.C. 99, 254 F. 2d 956; *Wembley* v. *Commissioner of Patents*, 352 F. 2d 941.

It is questioned by counsel for the plaintiff whether such a remedy by review of the final decision of the Patent Office would be adequate in such a case as is presented here. The Court concludes that it would be adequate. If the plaintiff loses ultimately in the Patent Office interference proceeding and brings an action *de novo* in this Court to review the final action of the Patent Office, this Court would be in a position to review interlocutory orders as well as the final order, and if it finds any error in any interlocutory order that was prejudicial and led to an erroneous final decision, this Court would be in a position to set aside and vacate the order of the Patent Office awarding priority to one of the plaintiff's opponents.

The cases principally relied on by counsel for the plaintiff do not support his contention to the effect that the courts may intervene during the pendency of an administrative proceeding and set aside and review interlocutory orders prior to the termination of the administrative proceeding. In *Gonzalez* v. *Freeman*, 334 F. 2d 570, the Court set aside a final order of the Secretary of Agriculture barring the plaintiffs from participating in certain contracts with the Commodity Credit Corporation. The Court did not interject itself during the pendency of the proceeding before the Secretary. In *Deering Milliken, Inc.* v. *Johnston*, 295 F. 2d 856, the Court held that a judicial review of an administrative proceeding could be had only after the proceeding was terminated and if an action was brought to review the final order of the administrative tribunal. The Court did hold that relief in the nature of mandamus could be granted against the administrative

agency if it unduly delayed its decision. That ruling is an entirely different result than that contended for here. *Kristensen* v. *McGrath*, 179 F. 2d 796, involved an action for a declaratory judgment to review a warrant of deportation. The Court of Appeals for this Circuit expressly pointed out at page 797 that the plaintiff had brought suit in the District Court for a declaratory judgment after exhausting his administrative remedies. In that case the administrative proceedings had been terminated and had come to a conclusion. *Holman* v. *Securities and Exchange Commission*, 299 F. 2d 127, involved a similar situation. There was an action in which the Court permitted the review of a suspension of the registration of a broker because of the consequences which followed the suspension. The order was final so far as the broker was concerned.

The Court finds, in conclusion, no basis for interfering with the Patent Office proceeding at this stage.

The Court is impressed with the force of the argument of plaintiff's counsel that the plaintiff is placed at a disadvantage in not being permitted to participate in the taking of testimony in behalf of his two opponents, but the Court refrains from expressing or intimating any definite opinion on that subject since this issue is not to be determined on this motion.

The motion to dismiss is granted.

/s/ Alexander Holtzoff
United States District Judge.

October 19, 1966.

IN THE UNITED STATES PATENT OFFICE
BEFORE THE PATENT BOARD OF INTERFERENCES

Patent Interference No. 94,426

SMITH AND ZELINSKI v. HORNE AND CARLSON v. SLOCOMBE

Decision of Board of Patent Interferences,

Dated March 18, 1966

Paper No. 52

In addition to the papers acknowledged in the order of February 11, 1966 (Paper No. 42), the following papers have been filed:

(1) Reply to Horne *et al.* opposition to Smith *et al.* motion to strike and to stay proceedings, filed on February 17, 1966, by Smith *et al.*;

(2) Opposition to Horne *et al.* motion for restriction and other relief, filed on February 17, 1966 by Smith *et al.*;

(3) Opposition to Smith *et al.* motion to stay proceedings, filed by Slocombe on February 11, 1966;

(4) Motion to remove Slocombe testimony, filed on February 17, 1966, by Slocombe;

(5) Concurrence by Slocombe to Horne *et al.* motion for restriction and other relief, filed on February 17, 1966.

The party Smith *et al.* has requested that an oral hearing be set to consider his motions. It is our opinion, however, that an oral hearing on the motions is unnecessary because from the various papers which have been filed, the position of each of the parties on the issues raised is clear. Accordingly, the request for an oral hearing is denied.

Smith *et al.* filed a motion to strike the respective records of Horne *et al.* and Slocombe. In the alternative, Smith *et al.*, by their motion, seek to have the records of Horne *et al.* and Slocombe refused to be received. The motion is based on the ground that Smith *et al.* were not given notice of the taking of testimony by either Horne *et al.* or Slocombe. Both Horne *et al.* and Slocombe filed oppositions to the Smith *et al.* motion to strike. In addition, Horne *et al.* filed a motion, concurred in by Slocombe, (a) to restrict Smith *et al.* from inspecting the priority testimony filed on behalf of Slocombe and Horne *et al.*; (b) for permission not to serve Smith *et al.* copies of the Horne *et al.* and Slocombe records; (c) permission to file two briefs at final hearing, one limited to the question of priority between Slocombe and Horne *et al.*, and a second directed to the question of the right to make the count, which latter brief only will be served on Smith *et al.*; and (d) for exclusion of Smith *et al.* from the portion of the final hearing dealing with the question of priority as between Slocombe and Horne *et al.* Smith *et al.* oppose the aforesaid motion by Horne *et al* and Slocombe.

A review of the record in this interference reveals that Smith *et al.* were placed under order to show cause as to Horne *et al.* and Slocombe for failure to allege a date in their preliminary statement prior to the respective filing dates of the other parties to this interference. In response to the order to show cause, Smith *et al.* filed a motion to dissolve based on the ground that the count is unpatentable to each of the parties, and on the ground that neither Slocombe nor Horne *et al.* have a right to make the sole count of the interference. The motion to dissolve was transmitted to the Primary Examiner only to the extent that it is based on the ground of lack of right to make. The motion was denied by the Primary Examiner. Thereafter, Smith *et al.* moved that the case be set down for final hearing for review of their motion to dissolve under Rule 258. This motion was granted and testimony times were set for only Horne *et al.* and Slocombe.

In support of their motion to strike, Smith *et al.* urge that Rule 273 requires that all opposing parties be given

notice of the taking of testimony by an opponent in an interference, which notice was not given to them. They further argue that irreparable injury will result to them since they were not present to cross-examine or take rebuttal testimony of witnesses with respect to any evidence introduced concerning the right of either Horne *et al.* or Slocombe to make the count and other issues which may be ancillary to priority.

Contrary to the assertions made by Smith *et al.*, neither a motion to dissolve by a junior party under order to show cause, nor a timely request that final hearing be set, is a satisfaction of an order to show cause. In the absence of an adequate showing, the aforesaid action by a junior party under order to show cause merely results in the withholding of entry of judgment against such party until the issues raised thereby are finally determined by the appropriate tribunal. Of course, if the issues raised thereby are resolved in favor of the junior party, an award of priority is made to him but only on the basis that the senior party or more senior junior party did not in fact disclose the invention in issue so that the party under order to show cause was in fact the only, and hence the first, inventor on the record before the Office. Smith *et al.*, are therefore at present in the position of a junior party under order to show cause as to each of the other parties in this interference.

Although Rule 273 requires that due notice of taking testimony be given "to the opposing party or parties", this Rule must be read and interpreted in the light of the other pertinent Rules, the circumstances involved, and the controlling case law, if any. Here, as noted above, Smith *et al.* are the junior party to both Horne *et al.*, and Slocombe, and have failed to allege any date in their preliminary statement which is earlier than the respective filing dates of Horne *et al.* and Slocombe. Under these circumstances, Smith *et al.* do not have the right to take testimony with respect to either Horne *et al.*, or Slocombe. See *Espenschied* v. *Sykes* v. *Wier*, 385 O.G. 3, 1929 C.D. 26. Further, in accordance with Rule 227(b), Smith *et al.* are

not entitled to access to either the Horne *et al.* or the Slocombe preliminary statements.

As noted above, Smith *et al.*, in accordance with Rule 227(b), are not permitted to have access to the preliminary statements of either of the other parties, and therefore, it is our belief, that to permit Smith *et al.* to be present at the taking of testimony by the other parties would be to defeat the intended purpose of the Rule, that is, that the dates and other information disclosed in the preliminary statements not be divulged to a junior party under order to show cause. In so far as the priority cases of both Horne *et al.* and Slocombe are concerned, Smith *et al.* are in the position of strangers to the proceeding. It is thus our opinion that it was unnecessary that Smith *et al.* be notified of the taking of testimony by Horne *et al.* and Slocombe. We are not persuaded by the Smith *et al.* arguments concerning any testimony that may have been taken with respect to the right to make the count, since it is long established that testimony concerning the right of a party to make the count will not normally be considered. See Shultz v. Dunhan, 401 O.G. 719, 1930 C.D. 11, citing Cooper v. Downing 1916 C.D. 227, and Fishburn *et al.* v. Vincent, 24 CCPA 1079, 88 F(2d) 711, 33 USPQ 156. In the event that the testimony does pertain in part to the right to make of either Horne *et al.* or Slocombe, the arguments of Smith *et al.* would have validity. Any other issues raised between the former two parties would not affect the case of Smith in any way. Accordingly, the motion by Smith *et al.* to strike the records of Horne *et al.* and Slocombe is granted to the extent that this Board will not consider at final hearing any part of those records in deciding the question of the right to make of these parties. The motion is denied in all other respects.

The Horne *et al.* motion for restriction of Smith *et al.* and other relief is not specifically provided for by the Rules of Practice. Such motion must therefore be decided on the basis of logic and the equities involved. Here, Smith et al., as discussed above, do not have the right to any information or evidence adduced in connection with the respective priority cases of Horne *et al.* and Slocombe,

and therefore in our opinion, the equities and logic in deciding this motion lie in favor of Horne *et al.* and Slocombe. To permit Smith *et al.* to have access to the priority cases of the other parties, or to be present during the oral arguments concerning those priority cases, would also defeat the intended purposes of Rule 227(b) and make Smith *et al.* privy to information to which they are not presently rightfully entitled. Accordingly, the Horne *et al.* motion, concurred in by Slocombe, is granted, and the following order is entered:

(1) Smith *et al.* are hereby denied access to the respective evidentiary records of Horne *et al.* and Slocombe;

(2) The parties Horne *et al.* and Slocombe need not serve copies of their respective evidentiary records on Smith *et al.*

(3) The parties Horne *et al.* and Slocombe are hereby granted permission to file two briefs at final hearing, one limited to the question of priority as between these parties, which briefs need not be served on Smith *et al.*, and a second brief directed to the question of the right to make, copy of which brief must be served on Smith *et al.*; and

(4) Smith *et al.* will be excluded from the portion of the final hearing dealing with the question of priority based on the evidentiary record between the parties Horne *et al.* and Slocombe, and will be denied access to the briefs relating thereto.

In view of our above action, the Smith *et al* motion to stay proceedings is dismissed as unnecessary.

The times remain as set in the order of January 21, 1966.

BOARD OF PATENT INTERFERENCES
GEORGE W. BOYS
Examiner of Interferences

JAMES S. BAILEY
Examiner of Interferences

L. H. GASTON
(Acting)
Examiner of Interferences

Decision of First Assistant Commissioner, Dated April 19, 1966

U.S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON, D.C. 20231

April 19, 1966

(Paper No. 59)

Interference No. 94,426

SMITH ET AL

v.

HORNE ET AL

v.

SLOCOMBE

PETITION

This is a petition by Smith et al. requesting that the decision rendered by the Board of Patent Interferences be reversed on each of six points which are set forth on pages 1 and 2 of the petition and need not be repeated here. In essence it is contended that the petitioners, who were placed under an order to show cause for failure to allege in their preliminary statement any date prior to the filing date of either Slocombe or Horne et al, were entitled to attend the taking of testimony by those parties, to receive copies of such testimony, to be present at the final hearing between those parties and to receive copies of their briefs as against each other, and that since the testimony was taken without notice to them it should be stricken.

Careful consideration of this case fails to disclose any material error in the thorough and well reasoned opinion of the Board of Patent Interferences, which is adopted here. The petitioners can prevail over the opposing parties only by establishing that their applications will not support the counts, and, if this is done, it is immaterial what their testimony shows. The petitioners did not request leave to take testimony as to the right of the opposing parties to make the counts and the possibility that the testimony taken by those parties might have some bearing on that issue is not thought to justify the relief requested by the petition.

Under the circumstances, no stay of proceedings is considered necessary.

The petition is denied.

EDWIN L. REYNOLDS
First Assistant Commissioner

Decision of First Assistant Commissioner, Dated May 13, 1966

U.S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON, D.C. 20231

May 13, 1966

(Paper No. 62)

Interference No. 94,426

SMITH ET AL

v.

HORNE ET AL

v.

SLOCOMBE

PETITION

The party Smith et al. requests reconsideration of the decision rendered in the above case on April 19, 1966.

The request has been carefully considered but is found to present no reason for modifying the decision in question. The original petition of Smith et al. was considered in full and denied in its entirety. It is neither practicable nor necessary to answer every argument raised in a petition nor to refer to each such argument in detail. The reasons for taking the action which was taken in the petition are thought to be sufficiently set forth therein and the present request is denied so far as it seeks any modification of the said decision.

EDWIN L. REYNOLDS
First Assistant Commissioner

§ 1002. Publication of information, rules, opinions, orders and public records

Except to the extent that there is involved (1) any function of the United States requiring secrecy in the public interest or (2) any matter relating solely to the internal management of an agency—

(a) Every agency shall separately state and currently publish in the Federal Register * * * (3) substantive rules adopted as authorized by law and statements of general policy or interpretations formulated and adopted by the agency for the guidance of the public, but not rules addressed to and served upon named persons in accordance with law. No person shall in any manner be required to resort to organization or procedure not so published.

§ 1009. Judicial review of agency action

Except so far as (1) statutes preclude judicial review or (2) agency action is by law committed to agency discretion.

Rights of review

(a) Any person suffering legal wrong because of any agency action, or adversely affected or aggrieved by such action within the meaning of any relevant statute, shall be entitled to judicial review thereof.

Form and venue of proceedings

(b) The form of proceeding for judicial review shall be any special statutory review proceeding relevant to the subject matter in any court specified by statute or, in the absence or inadequacy thereof, any applicable form of legal action (including actions for declaratory judgments or writs of prohibitory or mandatory injunction or habeas corpus) in any court of competent jurisdiction. Agency action shall be subject to judicial review in civil or criminal proceedings for judicial enforcement except to the extent that prior, adequate, and exclusive opportunity for such review is provided by law.

Acts reviewable

(c) Every agency action made reviewable by statute and every final agency action for which there is no other adequate remedy in any court shall be subject to judicial review. Any preliminary, procedural, or intermediate action or ruling not directly reviewable shall be subject to review upon the review of the final agency action. Except as otherwise expressly required by statute, agency action otherwise final shall be final for the purposes of this subsection whether or not there has been presented or determined any application for a declaratory order, for any form of reconsideration, or (unless the agency otherwise requires by rule and provides that the action meanwhile shall be inoperative) for an appeal to superior agency authority.

Relief pending review

(d) Pending judicial review any agency is authorized, where it finds that justice so requires, to postpone the effective date of any action taken by it. Upon such conditions as may be required and to the extent necessary to prevent irreparable injury, every reviewing court (including every court to which a case may be taken on appeal from or upon application for certiorari or other writ to a reviewing court) is authorized to issue all necessary and appropriate process to postpone the effective date of any agency action or to preserve status or rights pending conclusion of the review proceedings.

Scope of review

(e) So far as necessary to decision and where presented the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of any agency action. It shall (A) compel agency action unlawfully withheld or unreasonably delayed; and (B) hold unlawful and set aside agency action, findings, and conclusions found to be (1) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law; (2) contrary to constitutional right, power, privilege,

or immunity; (3) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right; (4) without observance of procedure required by law; (5) unsupported by substantial evidence in any case subject to the requirements of sections 1006 and 1007 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or (6) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court. In making the foregoing determinations the court shall review the whole record or such portions thereof as may be cited by any party, and due account shall be taken of the rule of prejudicial error. June 11, 1946, c. 324, § 10, 60 Stat. 243.

RULES OF PRACTICE of the UNITED STATES PATENT OFFICE in PATENT CASES

225. Failure of junior party to file statement or to overcome filing date of senior party. If a junior party to an interference fails to file a statement, or if his statement fails to overcome the prima facie case made by the filing date of the application of a senior party, such junior party shall be notified by an examiner of interferences that judgment upon the record will be rendered against him at the expiration of a time fixed by the examiner of interferences, not less than thirty days, unless cause be shown why such action should not be taken. Within this period any of the motions permitted by rules 231 to 236 may be brought, except that motions to dissolve (rule 232) must be limited to such matters as may be considered at final hearing (rule 258), but if a patent is not involved such junior party may file a statement as to his reasons for considering such claim or claims unpatentable, which statement shall be given due consideration by the primary examiner after the termination of the interference before acting on the application of the successful party. If a motion is denied by the primary examiner, the party under order to show cause may, within twenty days from the decision, request that final hearing be set to consider such matters as may be reviewed under rule 258.

226. Notice and access to applications. (a) After the preliminary statements have been received and approved, or the time for filing them has expired, the parties will be notified, and given the serial numbers and filing dates of the applications of each adverse party, including any applications which the parties may be entitled to inspect, and the parties will be permitted to see or obtain copies of each other's applications, except copies of affidavits filed under rules 131 and 202 and affidavits under rule 204 of the nature specified in rule 131 which shall be and remain sealed until preliminary statements are opened under rule 227. The preliminary statements are resealed by an examiner of interferences and shall not be revealed to the opposing parties except as provided in rule 227.

(b) The notices will also ordinarily specify the motion period (rule 231) and may also include an order to show cause (rule 225).

227. Access to preliminary statements. (a) The preliminary statements shall not be opened to the inspection of the opposing parties until after all motions under rules 231 to 236 and proceedings respecting the same have been finally disposed of or the time for filing such motions has expired without such a motion having been filed, and the case is in condition for taking of testimony.

(b) A junior party who fails to file a preliminary statement or a party who alleges no date in his preliminary statement earlier than the filing date of the application of another party shall not have access to the preliminary statement of said other party.

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247. Service of papers. Every paper filed in the Patent Office in interference cases must be served upon the other parties as provided in rule 248, except the following: (a) the application involved and any papers therein prior to the time the other party has the right of access thereto (rule 226), and any application referred to by the examiner in the notice of interference (rule 207) or by the party in a timely filed preliminary statement, (b) prelim-

inary statements, (c) ex parte requests for extension of time to file preliminary statements (rule 218), (d) documentary exhibits introduced at the taking of a disposition, (e) original transcripts of testimony (but copies of the record must be served (rule 253)), (f) statutory disclaimers under 35 U.S.C. 253 and (g) disclaimers, concessions of priority or abandonments of the invention under rule 262. The specification in certain rules that a designated paper must be served does not imply that other papers, not enumerated above, need not be served. However, the requirement for service of designated papers may be waived under particular circumstances and service may be required of other designated papers which need not ordinarily be served. Proof of such service must be made before the paper will be considered in the interference by the Office. A statement of the attorney, attached to or appearing in the original paper when filed, clearly stating the time and manner in which service was made will be accepted as prima facie proof of service.

248. Service of papers; manner of service. Service of papers must be on the attorney or agent of the party if there be such or on the party if there is no attorney or agent, and may be made in either of the following ways: (a) By delivering a copy of the paper to the person served; (b) by leaving a copy at the usual place of business of the person served with someone in his employment; (c) when the person served has no usual place of business, by leaving a copy at his residence, with a member of his family over 14 years of age and of discretion; (d) transmission by first class mail which may also be certified or registered. Whenever it shall be satisfactorily shown to the Commissioner that none of the above modes of obtaining or serving the paper is practicable, service may be by notice published in the Official Gazette.

251. Assignment of times for taking testimony. (a) Times will be assigned in which the junior party shall complete his testimony in chief, and in which the other party shall complete the testimony on his side, and a further time in which the junior party may take rebutting

testimony, but he shall take no other testimony. If there be more than two parties to the interference, the times for taking testimony will be so arranged that each shall have an opportunity to prove his case against prior parties and to rebut their evidence, and also to meet the evidence of junior parties.

(b) The time for taking testimony will ordinarily be assigned in notices sent to the parties after motions under rules 232 to 235 have been determined or, if no such motions have been filed, after the close of the motion period (rule 231). The date for final hearing will ordinarily be set in the same notices.

(c) Testimony shall be taken during the times assigned in accordance with rule 271 to 286.

253. Copies of the testimony. (a) In addition to the original transcript of the testimony (rules 275 to 278), three true copies of the record of each party must be filed, for the use of the Patent Office, and one true copy of the record must be served upon each of the opposing parties.

* * *

256. Final hearing. (a) Final hearings will be held by the Board of Patent Interferences on the day appointed at the designated time. If either party appear at the proper time, he will be heard.

* * *

271. Evidence must comply with rules. Evidence touching the matter at issue which shall not have been taken and filed in compliance with these rules will not be considered in determining the interference or other proceeding.

273. Notice of examination of witnesses. (a) Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in rule 248, of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name of a

witness is not known a general description sufficient to identify him or the particular class or group to which he belongs, together with a satisfactory explanation, may be given instead. The opposing party shall have full opportunity, either in person or by attorney, to cross-examine the witnesses. If the opposing party shall attend the examination of witnesses not named in the notice, and shall either cross-examine such witnesses or fail to object to their examination, he shall be deemed to have waived his right to object to such examination for want of notice. Neither party shall take testimony in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other cannot be had.

(b) The notice for taking testimony must be served (unless otherwise stipulated in an instrument in writing filed in the case) upon the attorney of record, if there be one, or, if there be no attorney of record, upon the adverse party. Reasonable time must be given therein for such adverse party to reach the place of examination. Such notice shall, with a statement signed by the attorney as to the fact, time, and mode of service thereof, be attached to the deposition or depositions, whether the opposing party shall have cross-examined or not.

279. Inspection of testimony. After testimony is filed in the Office, it may be inspected by any party to the case, but it cannot be withdrawn for the purpose of printing. It may be printed by someone specially designated by the Office for that purpose, under proper restrictions.

285. Effect of errors and irregularities in depositions. Notice will not be taken of merely formal or technical objections which shall not appear to have wrought a substantial injury to the party raising them; and in case of such injury it must be made to appear that, as soon as the party became aware of the ground of objection, he gave notice thereof.

(a) *As to notice.* All errors and irregularities in the notice for taking a deposition are waived unless objection is promptly made and served in writing upon the party giving the notice.

(b) *As to disqualification of officer.* Objection to taking a deposition because of disqualification of the officer before whom it is to be taken is waived unless made before the taking of the deposition begins or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence.

(c) *As to taking of deposition.* (1) Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time.

(2) Errors and irregularities occurring at the oral examination in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of the parties, and errors of any kind which might be obviated, removed, or cured if promptly presented, are waived unless seasonable objection thereto is made at the taking of the deposition.

(d) *As to completion and return of deposition.* Errors and irregularities in the manner in which the testimony is transcribed or the deposition is prepared, signed, certified, sealed, indorsed, transmitted, filed, or otherwise dealt with by the officer are waived unless a motion to suppress the deposition or some part thereof is made with reasonable promptness after such defect is, or with due diligence might have been, ascertained.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

No. 814

PHILLIPS PETROLEUM COMPANY,
Petitioner,

vs.

EDWARD J. BRENNER,
United States Commissioner of Patents,
Respondent,

and

PHILLIPS PETROLEUM COMPANY,
Petitioner,

vs.

GOODRICH-GULF CHEMICALS, INC.,
and MONSANTO COMPANY,
Respondents.

BRIEF FOR RESPONDENT GOODRICH-GULF CHEMICALS, INC. IN OPPOSITION TO PETITION FOR CERTIORARI

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Respondents.

BRIEF FOR RESPONDENT GOODRICH-GULF CHEMICALS, INC. IN OPPOSITION TO PETITION FOR CERTIORARI

This is simply a suit by plaintiff-petitioner seeking review of procedures established by the Commissioner of Patents under 35 U. S. C. § 6 and § 135(a) for conducting an interference. There has been no final action by the Patent Office in the interference, not even, as the Court of Appeals found,

any determination of petitioner's motion to dissolve the interference proceeding (App. 5a).*

The Court of Appeals holding that the present action is premature does not present any special or important reasons for review. There is no conflict with decisions of this Court or of any Court of Appeals, nor is there any departure from the accepted and usual course of judicial proceedings.

STATEMENT OF THE CASE

Plaintiff-petitioner is the junior party in a three-party interference and is under order to show cause why judgment should not be entered against its inventors (App. 2a). The only response to the order was a motion to dissolve the interference on the ground that the apparently senior applicants had no right to make the claim because their applications fail to describe what is claimed. The motion was denied by the Examiner who considered it, but a request that petitioner have a hearing on the motion by the Board of Patent Interferences was granted (App. 2a). This is the only contested issue to which petitioner is a party in the Patent Office. The contested issue between respondents Goodrich-Gulf Chemicals, Inc. and Monsanto Company in the Patent Office is that of priority of invention between their respective inventors; petitioner is not a party to this issue.

ARGUMENT

Petitioner's Questions Presented (Pet. 2) do not arise and its Reasons for Granting the Writ (Pet. 9) do not exist.

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*Page references herein are to the Petition cited as "Pet." and its Appendix cited as "App.".

The Court of Appeals did not hold that the Patent Office is immunized or uniquely free from review for procedural denial of due process (Question 1, Pet. 2, Reason 1, Pet. 9), or has a special status in that regard (Reason 2, Pet. 9), by reason of special review statutes (Question 2) or otherwise. To the contrary, the Court held that the Patent Office, like other Government agencies:

> "is subject to judicial review and restraint in case of arbitrary rules or rulings that infringe on private rights" (App. 4a).

The Court of Appeals has not denied relief where "concededly, hardship to the petitioner is inevitable if judicial relief is denied" (Question 3, Pet. 2-3) but specifically stated:

> "our comments on the availability of remedies in a court review of a final Patent Office order in no way imply that we have concluded the Patent Office has acted improperly vis a vis appellant" (App. 7a).

Finally, the Court of Appeals' decision is not one "abdicating its power to review Patent Office Action" (Reason 3, Pet. 9) but rather is based on that Court's conclusion:

> "Appellant's case is a far cry from those exceptional cases where a court may consider the validity of what is in form an interlocutory administrative order but is in substance a final determination of individual rights or a deprivation of a substantive statutory right" (App. 7a).

Petitioner has shown no error in that conclusion or the reasoning of the Court on which it is based.

Accordingly, the petition should be denied.

Respectfully submitted,

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SUPREME COURT, U. S.

FILED

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JOHN F. DAVIS, CLERK

No. 814

IN THE

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PHILLIPS PETROLEUM COMPANY, *Petitioner,*

v.

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BRIEF BY RESPONDENT MONSANTO COMPANY IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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EDWARD J. BRENNER, U. S. Commissioner of Patents and GOODRICH-GULF CHEMICALS, INC. and MONSANTO COMPANY, *Respondents.*

BRIEF BY RESPONDENT MONSANTO COMPANY IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Respondent Monsanto Company respectfully submits that the Petition for Writ of Certiorari should be denied.

The opinion of the Court below is reported at 154 U.S.P.Q. 211. The opinion of the District Court is reported at 260 F. Supp. 45 and 151 U.S.P.Q. 446.

QUESTIONS PRESENTED

1. Should the Courts review only final administrative agency decisions and avoid piecemeal consideration, except

   (a) where the review after final administrative decision allegedly will not be adequate, and/or

(b) where irreparable injury allegedly will result from waiting for Court review until after final agency action?

2. Is a "fair" trial sufficient or does petitioner have a right to a "perfect" trial?

COUNTERSTATEMENT OF THE CASE

Petitioner has overstated its case and amplification is required in the following respects in order to provide the proper perspective for consideration of the legal issues involved: The status of petitioner's assignors in the interference is merely that of a junior party "under order to show cause," i.e., their earliest *alleged* date of invention is later than the *filing* date of either of the assignors of the two corporate respondents. [*JA 4, 5, 74] [**App. 13a]. As such, petitioner's assignors have only the right to remain in the interference for the *sole* purpose of continuing to assert the alleged lack of disclosure in the applications of the other two parties [App. 13a, 14a]. Further, petitioner failed to move at the appropriate time for leave to take testimony on that issue [see App. 18a.] As to any points of controversy between the other two parties *vis-à-vis* each other, the petitioner and its assignors are merely "strangers to the proceeding" [App. 15a] and, as such, have no right to participate in the testimony taken to determine the issue of priority as between such other two parties [App. 16a].

Petitioner's exclusion from participation in the testimony was therefore proper; but assuming *arguendo*

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* The "JA" page references hereinafter are to the printed Joint Appendix in the Court of Appeals.

** The "App." page references hereinafter are to the printed Appendix at the end of the Petition for Writ of Certiorari.

the contrary, any error in this exclusion was corrected by the Patent Office ruling that in deciding the "right to make" of the other two parties to the interference, the two corporate respondents herein, the Board of Patent Interferences will *not* consider at final hearing any part of the records relating to testimony taken in the absence of petitioner [App. 15a]. The District Court said [App. 9a-10a]:

> "The Court is of the opinion that in accordance with the binding precedents and the *general rule* governing such matters, this Court should not interfere with the pending proceeding in the Patent Office until it is brought to a conclusion and then only it may review the interlocutory orders in an action sought to review the final order." [Emphasis added] [260 F. Supp. at 47].

The Court of Appeals said (App. 7a):

> "Appellant's case is a far cry from those exceptional cases where a court may consider the validity of what is in form an interlocutory administrative order but is in substance a final determination of individual rights of a deprivation of a substantive statutory right." [154 U.S.P.Q. at 214]

REASONS FOR NOT GRANTING THE WRIT

There is no important public question in the present case that would warrant the expenditure of this Court's limited time. More specifically:

A. Contrary to the allegations of petitioner, the Court of Appeals will review a Patent Office proceeding at an intermediate or interlocutory stage in a proper case.

B. Contrary to the allegations of petitioner, the Court of Appeals is not granting special status to the

Patent Office as compared to other administrative agencies but, rather, considered the nature of this particular Patent Office proceeding and the rulings made therein in deciding whether this particular case merited judicial intervention at this stage.

C. Contrary to the allegations of petitioner, the Court of Appeals is not abdicating its power to review Patent Office actions but, rather, affirmed the general rule against piecemeal review except in extraordinary circumstances which that Court found not to be present here.

ARGUMENT

Concise Summary of the Material Facts

The three corporate parties are all involved in an interference proceeding in the Patent Office based on three applications filed by their respective assignors, the petitioner's application having been filed nearly a year *after* the applications of respondents Goodrich-Gulf and Monsanto. The petitioner is therefore the juniormost party to the interference. Because in its preliminary statement (corresponding to the pleadings in an ordinary civil action) no date of invention was *alleged* on behalf of the petitioner's application as early as the actual filing dates of either respondent Goodrich-Gulf's application or respondent Monsanto's application, petitioner was placed under order to show cause why judgment on the record should not be rendered against it [App. 13a]. This was in accordance with Patent Office Rule 225 [App. 22a] and merely followed the practice of many decades' standing in interference proceedings in the Patent Office.

Petitioner avoided immediate judgment on the record against it by filing a motion to dissolve the inter-

ference on the ground that the assignors of respondents Goodrich-Gulf and Monsanto had no right to make the count of the interference because the subject matter thereof was not disclosed in their respective applications. The petitioner's motion to dissolve the interference was denied and, upon request by the petitioner, the issue raised by the motion to dissolve was set for consideration at final hearing in accordance with Rules 225 and 258 [App. 13a, 14a, 15a]. Consequently the petitioner, although the juniormost party, was permitted to remain in the interference solely for the limited purpose of arguing at final hearing the question of respondents Goodrich-Gulf's and Monsanto's right to make the count [App. 13a].

In the meantime, the corporate respondents Goodrich-Gulf and Monsanto proceeded during times set by the Patent Office to take testimony bearing on the issue of priority of invention *vis-à-vis each other*. In view of petitioner's position as juniormost party under order to show cause, plus its failure to move for leave to take testimony, neither respondent Goodrich-Gulf nor respondent Monsanto gave notice to petitioner of taking testimony.

The propriety of proceeding in such fashion was sustained first by the Board of Patent Interferences itself [App. 12a] and then by the Commissioner of Patents on petition [App. 17a and App. 19a].

Petitioner complains of the manner in which testimony was thus taken, and of being excluded from further proceedings insofar as these relate to the determination of priority as between the two corporate respondents.

POINTS AND AUTHORITIES

Petitioner argues in its brief that the Patent Office has violated some of its own rules. The petitioner is mistaken. The Patent Office has merely *interpreted* its own rules in view of a situation not specifically dealt with by the rules [App. 14a]. The Patent Office provided for just such a situation as the present one by Patent Office Rule 247 entitled "Service of Papers" wherein it is stated "However, the requirement for service of designated papers may be waived under particular circumstances and service may be required of other designated papers which need not ordinarily be served." [App. 23a, 24a]. With regard to Patent Office Rule 253 entitled "Copies of the Testimony" [App. 25a] which requires that ". . . . one true copy of the record must be served upon each of the *opposing parties*" [emphasis added], it is submitted that petitioner is not an *opposing party* for the purposes of this rule since petitioner has no right to take testimony [App. 14a].

Petitioner argues that under the doctrine of *Morgan* v. *Daniels*, 153 U.S. 120-125 (1894), it will be prejudiced since the interference will be decided on a defective record (Petition, p. 11). It is not seen how this can be true since it has already been ruled by the Patent Office that the testimony record will not be considered on the only point on which petitioner is entitled to be heard, namely, whether the corporate respondents' applications support the count [App. 15a]. However, and in any event, the District Court answered this argument quite adequately as follows [App. 10a]:

> "If the plaintiff loses ultimately in the Patent Office interference proceeding and brings an action *de novo* in this Court to review the final action of

> the Patent Office this Court would be in a position to review interlocutory orders as well as the final order, and if it finds any error in any interlocutory order that was prejudicial and led to an erroneous final decision, this Court would be in a position to set aside and vacate the order of the Patent Office awarding priority to one of the plaintiff's opponents." [260 F. Supp. at 47].

Petitioner argues (Petition, p. 12) in citing a recent 6th Circuit Court of Appeals decision, *Ochsner* v. *Millis,* 382 F. 2d 618, 155 U.S.P.Q. 195, 198 (6 Cir. 1967) that neither a 35 U.S.C. § 141 appeal nor a 35 U.S.C. § 146 civil action will provide adequate relief for petitioner. On its facts, of course, *Ochsner* has no pertinency to the present case. In *Ochsner,* both the senior party and the junior party in the interference were authorized to take testimony, and the junior party was engaged in taking the deposition of the senior party when, on advice of counsel, the senior party refused to answer certain questions. The *Ochsner* case was then brought in Federal District Court in an attempt to compel the senior party to answer those questions. Suits similar to the *Ochsner* case are not uncommon and indeed are specifically authorized under the Patent Laws—see 35 U.S.C. § 24. Unlike the petitioner here, Ochsner was not under order to show cause in the Patent Office and hence had the right to take testimony in the ordinary course of the interference. Here the petitioner, although he might have done so, failed to file a motion for leave to take testimony—see the Commissioner's remarks on this point at App. 18a.

Petitioner has suggested that the effect of the Court of Appeals decision in this case is that there can be no court review of any Patent Office orders in *inter partes*

interferences except the terminal order. Clearly the Court of Appeals indicated otherwise in its opinion where it said as follows:

> "Appellant's case is a far cry from those exceptional cases where a court may consider the validity of what is in form an interlocutory administrative order but is in substance a final determination of individual rights or a deprivation of a substantial statutory right." [App. 7a] [154 U.S.P.Q. at 214]

Petitioner has cited a number of cases which, on their facts, do not appear to be pertinent to the present case and so respondent makes no arguments with respect to these cases. However, petitioner does cite three recent companion cases of this Court, namely *Abbott Laboratories* v. *Gardner,* 387 U.S. 136; *Toilet Goods Association* v. *Gardner,* 387 U.S. 158; and *Gardner* v. *Toilet Goods Association,* 387 U.S. 167. It seems probable that the Court of Appeals considered all three of those cases since it specifically cited the *Abbott Laboratories* v. *Gardner* case, and all three were decided by this Court at the same time. Furthermore, respondent in its brief opposing petitioner's petition for rehearing before the Court of Appeals discussed in some detail the *Toilet Goods Association* case and that case is submitted to be especially pertinent to the present fact situation.

The *Toilet Goods Association* case involved a regulation merely to the effect that the Commissioner *may* authorize inspectors to examiner certain processes or formulae, etc. Consequently, pre-enforcement judicial review was deemed inappropriate at that stage because the controversy was not yet ripe for adjudication in that it was not clear *whether* or *when* such an inspection would be ordered, nor what *reasons* the Commis-

sioner of Foods and Drugs would give to justify his order. Note the striking parallel to the present case where it is self-evident that the *petitioner here has not yet been hurt.*

Applying that same principle to the situation presented by the present petition, the petitioner here, as we have seen, has *already* obtained complete and adequate relief before the administrative tribunal in question since *that tribunal has already ruled squarely in petitioner's favor* on whether it would give heed to any testimony by the two corporate respondents herein on the question of right to make—assuming *arguendo* that there was any such testimony. The Board squarely ruled that:

> "... this Board will not consider at final hearing any part of those records [of testimony by the opposing parties Horne et al. and Slocombe] in deciding the question of the right to make of these parties." [App. 15a]

Unless and until the Board of Patent Interferences should "renege" on its promise of record, petitioner has not been hurt in the slightest. What is even more important, the petitioner has not even suggested that the Board is *about* to renege. Moreover, it is again especially emphasized that the *petitioner failed to move for leave to take testimony* on the question of the alleged lack of right of its opponents to make the count of the interference, as it had the right to do. Consequently, having had the opportunity and duty to move, but having failed to do so [App. 17a, 18a], petitioner cannot now be heard to complain.

It appears to be the position of the petitioner that it is entitled to what might be suggested as a *perfect*

trial of its case before the Patent Office Board of Interferences. However, the courts have many times said that litigants have a right to a fair trial but not to a *perfect* trial (see the 1967 Cumulative Annual Pocket Part of 88 *Corpus Juris Secundum* at 88 CJS 20, citing *Miller* v. *Braun,* 196 Kan. 313 and *Walker* v. *Holiday Lanes, Inc.,* 196 Kan. 513). The record conclusively shows that, to date at least, the Patent Office has accorded petitioner every consideration to which as the juniormost party "under order to show cause" it is entitled. This is the very essence of a fair trial. Petitioner is not entitled to more.

It is respectfully submitted that this Court should deny the Petition for Writ of Certiorari.

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December, 1967

In the Supreme Court of the United States

OCTOBER TERM, 1967

No. 814

PHILLIPS PETROLEUM COMPANY, PETITIONER

v.

EDWARD J. BRENNER, COMMISSIONER OF PATENTS

and

PHILLIPS PETROLEUM COMPANY, PETITIONER

v.

GOODRICH-GULF CHEMICALS, INC., and
MONSANTO COMPANY

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE RESPONDENT EDWARD J. BRENNER, COMMISSIONER OF PATENTS, IN OPPOSITION

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1. The petitioner and respondents Goodrich-Gulf Chemicals, Inc. ("Goodrich-Gulf") and Monsanto

Company ("Monsanto") are the assignees of inventors who filed separate applications with the United States Patent Office for a patent on a process for producing polybutadiene polymers, used as a synthetic rubber.[1] The three applications were placed in interference by the Patent Office in July 1964.[2] Since petitioner swore to a date of conception subsequent to the filing dates of the other inventors, the Patent Office Interference Examiner, in October 1964, issued an order to show cause why judgment should not be entered against petitioner. In response, petitioner moved to dissolve the interference on the ground that the apparently senior applicants had no right to make their claim because of lack of adequate disclosure of the invention in their applications. Although this motion was initially denied by the Patent Office Primary Examiner, to whom it had been referred, the Patent Office Interference Examiner subsequently granted petitioner's request that the motion be set for final consideration and disposition at the final hearing of the interference (Pet. App. 2a).

Goodrich-Gulf and Monsanto, who continued to dispute between themselves as to which had priority, took depositions without notice to petitioner and adduced other evidence on that separate issue (Pet. App. 2a-3a). Thereafter, petitioner moved that the record

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[1] For convenience, no distinction will be made in this memorandum between the assignors and their respective assignees.

[2] 35 U.S.C. 135 authorizes the Commissioner of Patents to institute an administrative adversary proceeding, called an "interference," in which the question of priority between rival claimants is determined by a Board of Patent Interferences.

made by Goodrich-Gulf and Monsanto be stricken or not received by the Interference Examiner, and to stay interference proceedings pending the determination of the motion (Pet. App. 13a). Goodrich-Gulf and Monsanto cross-moved to restrict petitioner from inspecting the priority testimony in the interference, and for an order excluding petitioner from that portion of the final interference proceeding dealing solely with the issue of priority between Goodrich-Gulf and Monsanto (*ibid.*). On March 18, 1966, the Board of Patent Interferences denied petitioner's motions and granted the motions of Goodrich-Gulf and Monsanto (Pet. App. 12a-16a). The Board reasoned that since petitioner had failed to allege a date of invention earlier than the date of filing of the Goodrich-Gulf and Monsanto applications, petitioner was "in the position of [a] stranger" to the priority contest between the latter (Pet. App. 14a-15a).[3] The Board rejected petitioner's contention that the testimony adduced by Goodrich-Gulf and Monsanto might be relevant in determining the sole question remaining with respect to petitioner's application—*viz.*, whether the senior applicants had no right to make their claim because of the lack of adequate disclosure of the invention in their applications—stating that "it is long

[3] For this reason, the Board held inapplicable to the instant case Rule 273 of the Patent Office Rules (Pet. App. 25a-26a), which provides that due notice of taking testimony in an interference must be given "to the opposing party or parties." The Board relied, in part, upon Patent Office Rule 227(b) (Pet. App. 23a), which provides that a junior party shall not have access to the preliminary statement of a senior party.

established that testimony concerning the right of a party to make * * * [his claim] will not normally be considered" (Pet. App. 15a).[4]

On April 19, 1966, the First Assistant Commissioner, acting on behalf of the Commissioner of Patents, denied petitioner's petition to review the Board's decision of March 18, 1966 (Pet. App. 17a-18a).[5] Thereafter, on May 13, 1966, the First Assistant Commissioner, acting on behalf of the Commissioner of Patents, denied petitioner's request for reconsideration of the Commissioner's decision of April 19, 1966 (Pet. App. 19a).

Petitioner then instituted an action in the United States District Court for the District of Columbia, purportedly under Section 10 of the Administrative Procedure Act, 5 U.S.C. 1009, and Fed. R. Civ. Proc. 81(b), for declaratory and injunctive relief against the Commissioner of Patents. By this suit, and a companion action brought in the same court against Goodrich-Gulf and Monsanto, petitioner sought to obtain an order permitting it (1) to cross-examine witnesses, to introduce rebuttal evidence, and to have access to all records at the interference, and (2) to attend and take part fully in all aspects of the final

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[4] The Board also stated that if any testimony did relate in part to this issue, it would not be considered at the final hearing (Pet. App. 15a).

[5] The Commissioner stated, *inter alia*, that petitioner "did not request leave to take testimony as to the right of the opposing parties to make the * * * [claims] and the possibility that the testimony taken by those parties might have some bearing on that issue is not thought to justify the relief requested by the petition." (Pet. App. 18a)

hearing in the interference. The district court dismissed the complaint in both actions on the ground that the Patent Office orders sought to be reviewed were interlocutory (Pet. App. 8a-11a).[6] The court of appeals affirmed on the same ground—*viz.*, that the case was premature for judicial review since there was no final agency action of the Patent Office (Pet. App. 1a-7a).[7]

2. This decision, we believe, is clearly correct. As the court of appeals stated, "[t]he prematurity of the present action plainly appears from consideration of the successive possibilities that may lie ahead" (Pet. App. 6a). Petitioner may still prevail in the Patent Office on its motion to dissolve the interference on the ground that the other two applications do not adequately set forth the invention. If petitioner should lose before the Patent Office, the final decision of the Patent Office awarding priority to another party would be reviewable by the United States Court of Customs and Patent Appeals (35 U.S.C. 141), or by a civil action in the United States District Court (35 U.S.C. 145).

Contrary to petitioner's assertion (Pet. 11-12), judicial review of final Patent Office action would afford petitioner a complete and adequate remedy at law. If the Court of Customs and Patent Appeals or the Unit-

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[6] The district court's opinion is reported at 260 F. Supp. 45.

[7] Both the district court and the court of appeals expressly stated that they were not passing upon the propriety of the Patent Office procedure in the instant case (Pet. App. 7a, 11a).

ed States District Court should agree with petitioner's contention that the Patent Office procedure is improper, either Court may set aside the allowance of priority.[8] The authority of the Court of Customs and Patent Appeals to remand the case for further proceedings in the Patent Office is clear.[9] While there is doubt whether the district court may similarly order a remand as such,[10] the court of appeals observed that the district court can "provide equivalent relief by staying its proceeding pending further proceedings in the Patent Office" (Pet. App. 6a).[11] In any event, whatever specific procedure is utilized, there is no doubt, as the court below held, that "courts reviewing arbitrary Patent Office final action will generally

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[8] Although petitioner emphasizes (Pet. 11) the presumption of correctness of the Patent Office determination (*Morgan* v. *Daniels*, 153 U.S. 120), this presumption would be effectively rebutted on a showing of prejudicial error.

Ochsner v. *Millis*, 382 F. 2d 618 (C.A. 6), cited by petitioner (Pet. 12), did not involve any question of the right of a party to obtain judicial review of the non-final action of an administrative agency.

[9] See, *e.g.*, *Vandenberg* v. *Reynolds*, 44 CCPA 873, 242 F. 2d 761.

[10] 35 U.S.C. 141 provides that the adverse party in the Court of Customs and Patent Appeals may elect to have further proceedings conducted pursuant to 35 U.S.C. 146—*i.e.*, by civil action in the District Court.

[11] See *Hoover Co.* v. *Coe*, 325 U.S. 79, 89. See, also, *International Standard Elec. Corp.* v. *Ooms*, 157 F. 2d 73, 75 (C.A.D.C.); *California Research Corp.* v. *Ladd*, 356 F. 2d 813, 818-819 (C.A.D.C.). *Cf. Knutson* v. *Gallsworthy*, 164 F. 2d 497, 507 (C.A.D.C.).

be able to fashion remedies they deem needful to correct injustices" (Pet. App. 7a).[12]

For the foregoing reasons the petition for a writ of certiorari should be denied.[13]

Respectfully submitted,

ERWIN N. GRISWOLD,
Solicitor General.

DECEMBER 1967.

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[12] See *Hoover Co.* v. *Coe*, *supra*, 325 U.S. at 84, where this Court described the two statutory review provisions as "alternative remedies resulting in the same sort of relief."

[13] While petitioner's failure to obtain a final agency decision is dispositive, we also note the lack of merit in petitioner's claim of prejudicial error in the Patent Office procedure. Since petitioner's claim relates solely to what appeared on the face of the other two applications, the Board of Patent Interferences correctly ruled (*supra*, p. 3), that petitioner was a stranger to the priority contest between Goodrich-Gulf and Monsanto, and therefore was properly excluded from the portion of the interference relating solely to the priority issue. Moreover, as the First Assistant Commissioner stated (*supra*, n. 5), petitioner did not make a properly supported motion to take the testimony of the other parties on the only issue in which petitioner had an interest (the adequacy of the disclosure in their applications).

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